

## **REMARKS**

Claims 1-14 are pending in the subject application. Claims 1-13 were rejected and claim 14 was allowed. Applicant has amended claims 1, 7, and 13 in order more particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant has not added or deleted any claims. Accordingly, claims 1-14 are presently being examined.

In view of the following Amendment and Response, applicant respectfully requests that the Examiner reconsider and withdraw the rejections made in the outstanding Office Action.

### **Support for the Amendments**

Applicant has amended claims 1, 7, and 13 in order more particularly point out and distinctly claim the subject matter of applicant's ingestible composition. Specifically, applicant has amended independent claims 1, 7, and 13, and the claims dependent thereon, to add "provided that the ethyl 4-(thioacetoxyl)butyrate is not part of a naturally occurring mixture of compounds or part of a synthetic mixture of compounds which is the same as the naturally occurring mixture of compounds". Applicant has entered these amendments in order to overcome the Examiner's rejections.

This amendment to the claims is fully supported in the specification as originally filed, and thus no new matter is introduced by these amendments in accordance with 35 U.S.C. Section 132. Accordingly, applicant requests entry of these amendments.

**Allowance of Claim 14.**

Applicant acknowledges with appreciation that the Examiner has allowed claim 14, which claim recites a method for preparing ethyl 4-(thioacetoxyl)butyrate which comprises reacting ethyl 4-chlorobutyrate with potassium thioacetate.

**Rejection of Claim 13 under 35 U.S.C. Section 102(a) as being Anticipated by Applicant's Disclosure.**

The Examiner has rejected claim 13 under 35 U.S.C. Section 102(a) as being anticipated by applicant's disclosure. The Examiner states that applicant teaches that ethyl 4-(thioacetoxyl) butyrate is a natural product obtained from mango (page 1 of specification). Applicant's claims as amended obviate the Examiner's rejection.

Claim 13 recites ethyl 4-(thioacetoxyl)butyrate represented by the formula,  $\text{CH}_3\text{COS}(\text{CH}_2)_3\text{COOCH}_2\text{CH}_3$ . As set out above, applicant has amended independent claim 13 to add "provided that the ethyl 4-(thioacetoxyl)butyrate is not part of a naturally occurring mixture of compounds or part of a synthetic mixture of compounds which is the same as the naturally occurring mixture of compounds".

Accordingly, the Examiner's rejection of claim 13 under 35 U.S.C. Section 102(a) as being anticipated by applicant's disclosure should be withdrawn.

**Rejection of Claims 1-12 under 35 U.S.C. Section 103(a) as Being Unpatentable over Applicant's Disclosure.**

The Examiner has rejected claims 1-12 under 35 U.S.C. 103(a) as being obvious over applicant's disclosure. The Examiner states that applicant discloses that

ethyl 4-(thioacetoxy) butyrate is a natural product obtained from mango (page 1 of the specification). The Examiner argues that the claims differ as to the use of the claimed compound in specific food products. The Examiner alleges that it is notoriously well-known that sulfur compounds are useful in modifying or enhancing taste properties (pages 2-4 of the specification). The Examiner concludes that it would have been obvious to use ethyl 4-(thioacetoxy) butyrate in different food products, such as chewing gums and confections, because the use of sulfur compounds to enhance taste properties in food products is well-known in the art. Applicant's claims as amended obviate the Examiner's rejection.

Applicant's claim 1 recites a method for flavoring an ingestible composition which comprises admixing an ingestible vehicle with an organoleptically effective amount of ethyl 4-(thioacetoxy)butyrate represented by the formula,  $\text{CH}_3\text{COS}(\text{CH}_2)_3\text{COOCH}_2\text{CH}_3$ . Applicant's claim 7 recites an ingestible composition comprising (i) an ingestible vehicle; and (ii) an organoleptically effective amount of ethyl 4-(thioacetoxy)butyrate represented by the formula,  $\text{CH}_3\text{COS}(\text{CH}_2)_3\text{COOCH}_2\text{CH}_3$ . As set out above, applicant has amended independent claims 1 and 7, and the claims dependent thereon, to add "provided that the ethyl 4-(thioacetoxy)butyrate is not part of a naturally occurring mixture of compounds or part of a synthetic mixture of compounds which is the same as the naturally occurring mixture of compounds".

The Examiner cites no reference teaching or suggesting the use of applicant's flavoring agent. In the absence of such teachings, the Examiner cannot assert that "it is notoriously well-known that sulfur compounds are useful in modifying or enhancing taste properties".

[A]s a matter of law under 35 U.S.C. Section 103, the examiner must substantiate his "suspicions" on the basis of facts drawn from proper prior art. The issue to be resolved requires more than "suspicions;" it requires facts.... The provisions of section 103 must be followed realistically to develop the factual background against which the section 103 determination must be made. All of the facts must be considered.... In re Lunsford, 357 F.2d 380, 391, 148 U.S.P.Q. 716, 725 (C.C.P.A. 1966) [emphasis in original].

The provisions of Section 103 must be followed realistically to develop the factual background against which the Section 103 determination must be made. It is not proper within the framework of Section 103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary for the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. The references of record fail to teach or suggest applicant's invention as a whole.

Accordingly, the Examiner's rejection of claims 1-12 under 35 U.S.C. 103(a) as being obvious over applicant's disclosure should be withdrawn.

Obviousness of a composition or process must be predicated on something more than it would be obvious "to try" the particular component recited in the claims or the possibility it will be considered in the future, having been neglected in the past. *Ex parte Argabright et al.* (POBA 1967) 161 U.S.P.Q. 703. There is usually an element of "obvious to try" in any research endeavor, since such research is not undertaken with complete blindness but with some semblance of a chance of success. "Obvious to try" is not a valid test of patentability. *In re Mercier* (CCPA 1975) 515 F2d 1161, 185 U.S.P.Q. 774; *Hybritech Inc. v. Monoclonal Antibodies, Inc.* (CAFC 1986) 802 F2d 1367, 231 U.S.P.Q. 81; *Ex parte Old* (BPAI 1985) 229 U.S.P.Q. 196; *In re Geiger* (CAFC 1987) 815 F2d 686, 2 U.S.P.Q.2d 1276. *In re Dow Chemical Co.* (CAFC 1988) F2d, 5 U.S.P.Q.2d 1529. Patentability determinations based on that as a test are contrary to statute. *In re Antonie* (CCPA 1977) 559 F2d 618, 195

U.S.P.Q. 6; *In re Goodwin et al.* (CCPA 1978) 576 F2d 375, 198 U.S.P.Q. 1; *In re Tomlinson et al.* (CCPA 1966) 363 F2d 928, 150 U.S.P.Q. 623. A rejection based on the opinion of the Examiner that it would be "obvious to try the chemical used in the claimed process which imparted novelty to the process does not meet the requirement of the statute (35 U.S.C. 103) that the issue of obviousness be based on the subject matter as a whole. *In re Dien* (CCPA 1967) 371 F2d 886, 152 U.S.P.Q. 550; *In re Wiaains* (CCPA 1968) 397 F2d 356, 158 U.S.P.Q. 199; *In re Yates* (CCPA 1981) 663 F2d 1054, 211 U.S.P.Q. 1149. Arguing that mere routine experimentation was involved overlooks the second sentence of 35 USC 103. *In re Saether* (CCPA 1974) 492 F2d 849, 181 U.S.P.Q. 36. The issue is whether the experimentation is within the teachings of the prior art. *In re Waymouth et al.* (CCPA 1974) 499 F2d 1273, 182 U.S.P.Q. 290. The fact that the prior art does not lead one skilled in the art to expect the process used to produce the claimed product would fail does not establish obviousness. *In re Dow Chem. Co.* (CAFC 1988) 5 U.S.P.Q.2d 1529.

### **Prior Art**

The Examiner further states that the prior art cited is deemed to be relevant to the claimed invention.


Applicant submits that detailed discussion of these references is not necessary or appropriate at this time because these references are inferior to the specific references discussed above and because the Examiner has not specifically cited these references against any of the claims in this application.

In view of the foregoing Amendment and Response, applicants request reconsideration pursuant to 37 C.F.R. Section 112 and allowance of the claims pending in this application. Applicant requests the Examiner to telephone the undersigned

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attorney should the Examiner have any questions or comments which might be most expeditiously handled by a telephone conference. No fee is deemed necessary in connection with the filing of this Amendment and Response. If any fee is required, however, authorization is hereby given to charge the amount of such fee to Deposit Account No. 13-4822.

Respectfully submitted,

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